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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,199	04/14/2004	Jonathan Willinger	JWIL 20.354 (100668-00107	5866

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EXAMINER	
NGUYEN, TRINH T	

ART UNIT	PAPER NUMBER
3644	

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/824,199	WILLINGER ET AL.	
	Examiner	Art Unit	
	Trinh T. Nguyen	3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Amendment dated 8/23/06*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1,3-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. In claims 1 and 14: the phrase "the contiguous field" is confusing since it is unclear as to what the term "the contiguous field" is referring to (i.e., is the term "the contiguous field" is the same term or different term as the term "the common field" as defined earlier in claims 1 and 14?); the term "the field" is confusing since it is unclear as to what the term "the field" is referring to (i.e., is the term "the field" is the same term or different term as the terms "the contiguous field" and/or "the common field" as defined earlier in claims 1 and 14?

4. Claims 1 and 14 recites the limitation "the contiguous field". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-5, 8, 12-16, 18,20 and 21, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Iacovelli et al. (US 6,794,013; see attached Figures 1 and 8 for further explanation).

For claims 1 and 14 and 20, Iacovelli et al. disclose a mat comprising: a planar upper surface; a plurality of raised bumps (18,48,44,28,24,46) arranged in a common field (common field is defined as the area where the plurality of raised bumps (18,48,44,28,24,46) are located thereon) on said upper surface in an irregular, asymmetric pattern; a peripheral edge (30); and wherein said plurality of bumps are sized and spaced such that when the bowl is placed anywhere in the field, the bowl normally falls within interstices of the bumps and is restrained by said bumps in a plurality of non-dedicated locations; a bottom surface resisting sliding with respect to a support surface (see attached Figure 8 especially).

For claim 3, Iacovelli et al. disclose the raised peripheral edge has an irregular shape.

For claims 4 and 15, Iacovelli et al. disclose the raised peripheral edge has a shape that, when viewed from the top of the pet mat, is partially curved and partially straight.

For claims 5 and 16, Iacovelli et al. disclose the plurality of bumps further comprises a series of bumps (18,48,44,28,24,46) spaced from the raised peripheral edge to prevent a bowl placed on said upper surface from moving toward said raised peripheral edge.

For claims 8 and 18, Iacovelli et al. disclose the upper surface further comprises a decorative image (note that the arrangement of portions 18,48,44,28,24,46 formed a decorative image) and wherein said raised peripheral edge has a shape that is similar to a portion, but not the entirety, of said decorative image.

For claim 12, Iacovelli et al. disclose at least one bowl placement locator (48) formed on said upper surface.

For claim 13, Iacovelli et al. disclose at least one bowl placement locator is part of an ornamental design embossed or imprinted on said upper surface.

It is noted that Iacovelli et al.'s mat is capable of being used as a pet mat since Iacovelli et al.'s mat comprises the satisfying structural members that can be used by a pet. Further, note that it is well settled case law that such limitations, which are essentially method limitations or statements or intended or desired use, do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 152 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647; and MPEP 2114 & 2115.

For claim 21, it should be noted that a recitation (i.e., "sufficient to accommodate a width of a rim of a pet bowl") of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Presently, the Iacovelli et al. reference provides the claimed structure (i.e., a plurality of raised bump wherein

each bump are spaced from an adjacent bump), and is therefore, capable of functioning as claimed.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 6, 7, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iacovelli et al. (US 6,794,013) in view of Lampe (US 5,743,210).

As described above, Iacovelli et al. disclose most of the claimed invention except for indicating that the mat is made from a non-stick, tacky material wherein the tacky material is natural rubber.

Lampe teaches the concept of using a non-stick, tacky pad/material (70), wherein the tacky pad/material is made from a rubber-like material, on the bottom of a structural member (22) so as to prevent the structural member from sliding about. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mat of Iacovelli et al. so as to include the use of a non-stick, tacky pad/material on the bottom of the mat, in a similar manner as taught in Lampe, in order to prevent the mat from sliding about. Regarding the tacky material is natural rubber, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select such a material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended

use as a matter of obvious design choice. Also, since applicant did not provide a reason and/or showing any criticality as to why the material has to be natural rubber, it is believe that through trial and error during the manufacturing process that one comes up with the most efficient material to meet the design criteria (see page 3 of the specification, Applicant only stated that "The pet mat 10 of the present embodiment is preferably formed from a non-stick, tacky material, such as natural rubber").

9. Claims 9-11, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iacovelli et al. (US 6,794,013).

As described above, Iacovelli et al. disclose most of the claimed invention except for indicating that the decorative image has a specific shape (i.e. the decorative image is a pair of paw prints which is defined by a plurality of oval digits and a circular palm portion). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the mat of Iacovelli et al. in whatever form or shape was desired or expedient, wherein applicant did not provide a reason or a stated problem is solved by having the specific shape as claimed versus the shape taught by the prior art. Note that a change in form or shape is generally recognized as being well known within the level to one of ordinary skill in the art depending on one's intended use. Furthermore, note that in lines 15 and 16 of page 3 of the specification, applicant stated that "although other ornamental designs are contemplated"; therefore, it is believe that through trial and error in the manufacturing procedure that one comes up with a particular shape to meet the require design criteria for manufacturing of a pet mat.

Response to Arguments

10. Applicant's arguments filed 8/23/06 have been fully considered but they are not persuasive.

11. With respect to Applicant's remark regarding "a pet bowl", it is noted that Iacovelli et al.'s mat is capable of being used to retain a pet bowl thereon since Iacovelli et al.'s mat comprises the satisfying structural members (i.e., the plurality of bumps) that can be used to retain a pet bowl (see attached Figure 8).

12. With respect to Applicant's remark regarding that Iacovelli fails to teach structure that allows placement of a pet bowl at anywhere in the field bumps. It is noted that the limitation "a pet bowl is placed anywhere" as claimed in claims 1 and 14 is an intended or desired use limitation, which does not serve to patentably distinguish the claimed structure over that of the reference.

13. With respect to Applicant's remark regarding "irregular, asymmetric pattern", it is noted that, as shown in attached Figure 1, Iacovelli et al.'s mat comprises a plurality of raised bumps (18,48,44,28,24,46) arranged in a common field (common field is defined as the area where the plurality of raised bumps (18,48,44,28,24,46) are located thereon) on the upper surface in an irregular, asymmetric pattern.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T. Nguyen whose telephone number is (571) 272-6906. The examiner can normally be reached on M-F (9:30 A.M to 6:00 P.M). The examiner's supervisor, Teri Luu can be reached on (571) 272-7045 for the purpose of status inquiry only. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

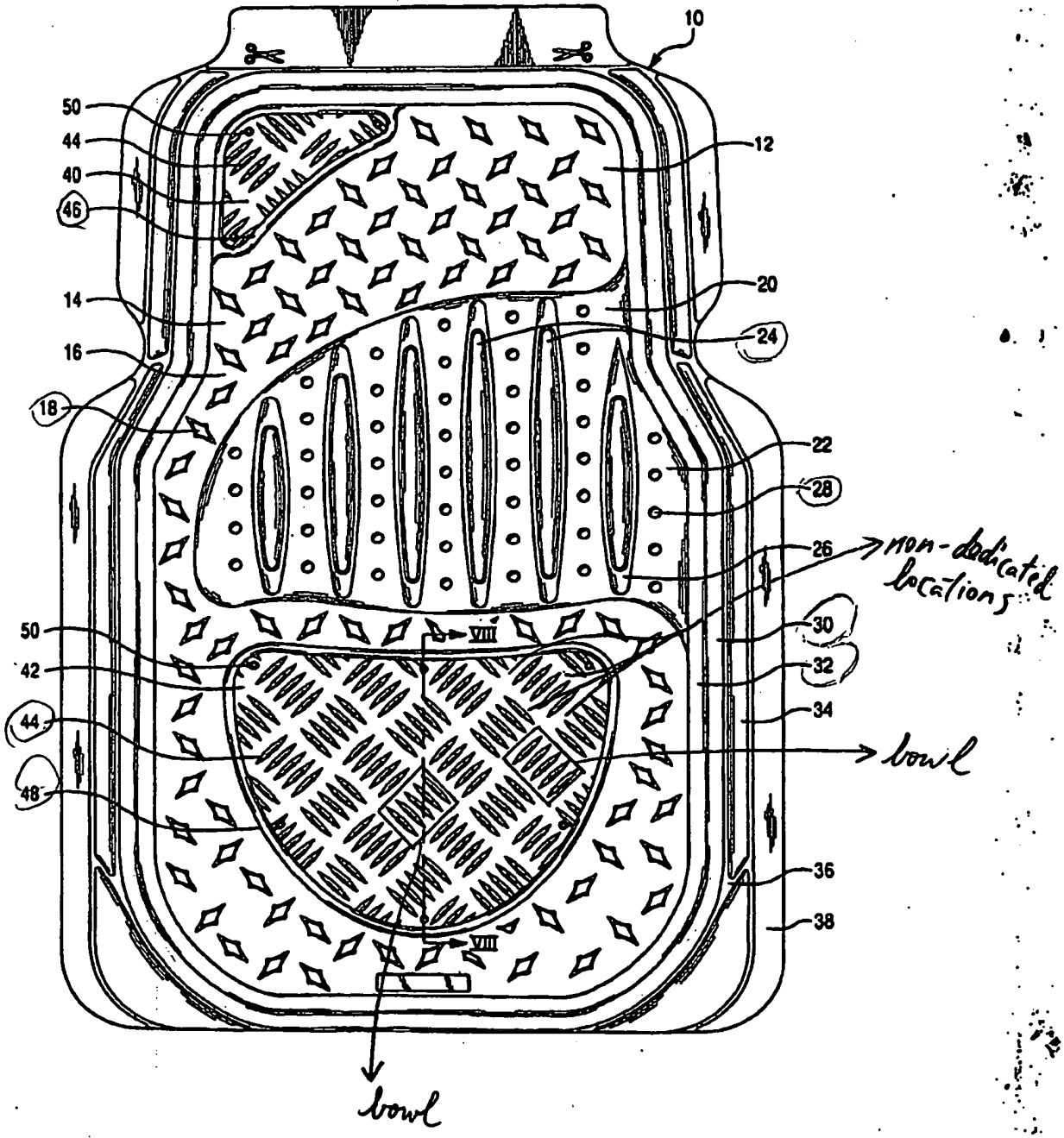
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

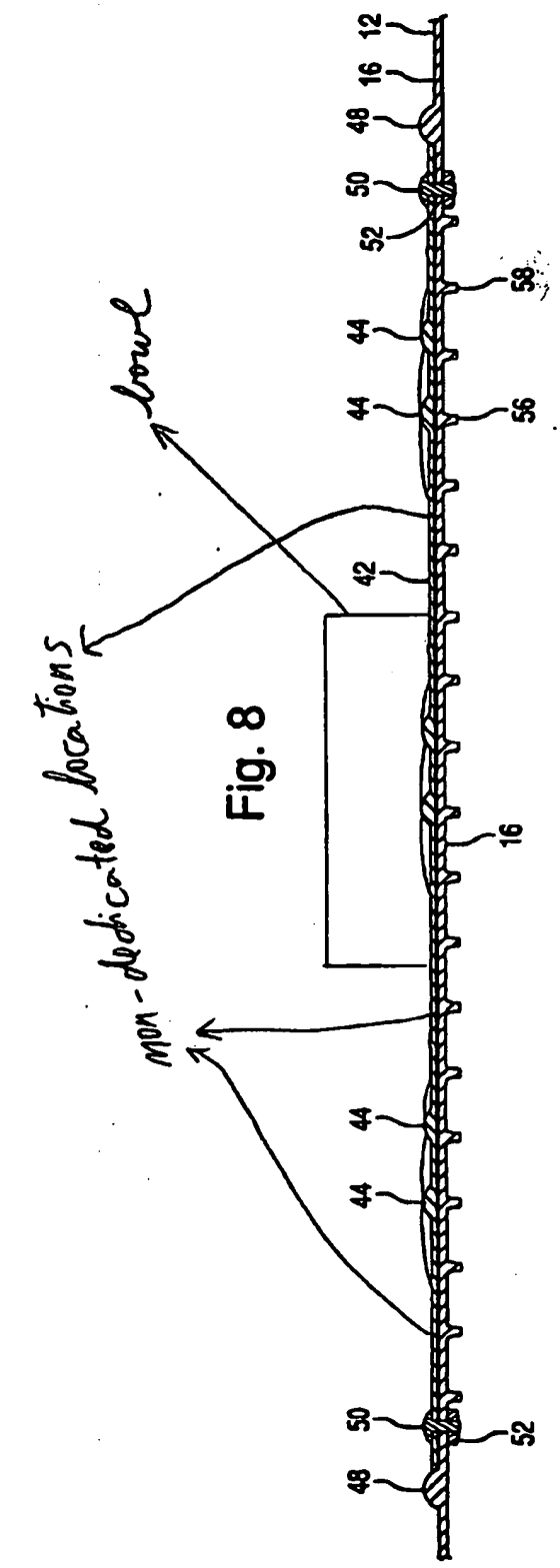
Trinh T Nguyen
Primary Examiner
Art Unit 3644

10/24/06

U.S. Patent Sep. 21, 2004 Sheet 1 of 6 US 6,794,013 B1

Fig. 1




12
16
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bowl
non-dedicated locations

Fig. 8